UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte LORRAINE MIGNAULT

Appeal 2007-1937
Application 09/762,232
Technology Center 1600

Decided: July 2, 2007

Before TONI R. SCHEINER, DONALD E. ADAMS, and RICHARD M. LEBOVITZ, *Administrative Patent Judges.*

LEBOVITZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 5-9, 17-20, 22, 24-26, and 30. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE

The broadest claim on appeal is drawn to an "additive" comprising filtered oatstraw extract prepared with magnetized water. In addition to this claim, the oatstraw extract is claimed in combination with lavender oil and glycerine, and for use in treating "pain, swelling, itching, or inflammation."

Claims 1, 5-9, 17-20, 22, 24-26, and 30, which are all the pending claims, stand finally rejected over prior art (Br. 1). The Examiner relies on the following references as evidence of unpatentability:

Puchalski	US 4,690,818	Sep. 1, 1987
Ito	US 5,055,189	Oct. 8, 1991
Jakobson	US 5,397,497	May 14, 1995
Patrasenko (Abstract only)	RU 2085296	Jul. 27, 1997

Weed, "Wise Woman, Herbal healing wise," 1989, pp. 192-205.

Claims 1, 5-9, 17-20, 22, 24-26, and 30 stand rejected under 35 U.S.C. § 103(a) as obvious over Weed in view of Puchalski and Jakobson, and further in view of Ito or Patrasenko (Answer 3). Appellant has set forth seven different claim groupings, and has argued that the claims in each grouping stand or fall together (Br. 6). For each group, they identify the independent claim as representative, i.e., claims 1, 8, 17, 18, 20, 25, and 26 (Br. 6). Claim 5-7, 9, 19, 22, 24, and 30 stand or fall with the independent claims because they were not separately argued. *See* 37 C.F.R. § 41.37(c)(1)(vii). Claims 1, 8, 17, 18, 20, 25, and 26 read as follows:

1. A topical lotion for relieving pain, swelling or inflammation comprising: glycerine; lavender oil; and the active ingredient consisting of oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles.

8. A method of treating pain, swelling, itching or inflammation comprising:

providing a topical lotion the lotion consisting essentially of:

at least 50% oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated

water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles;

at least 25% glycerine; and

0.1-0.2% lavender oil,

the sum of these three components being 100%; and

applying the lotion topically to inflamed, painful or swollen areas.

17. An additive comprising:

a mixture consisting essentially of:

at least 50% oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles;

at least 25% glycerine; and

0.1-0.2% lavender oil,

the sum of these three components being 100%; and

a suitable carrier.

18. A hair or body product comprising:

a mixture consisting essentially of:

at least 50% oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles;

at least 25% glycerine; and

0.1-0.2% lavender oil,

the sum of these three components being 100%; and

a suitable carrier.

20. A process for preparing an oatstraw extract comprising:

providing a quantity of oatstraw;

magnetically treating a quantity of water;

heating the magnetically treated water;

placing the oatstraw in the magnetically treated heated water, thereby producing an oatstraw mixture; and

filtering the oatstraw mixture, thereby producing an oatstraw extract.

25. A topical lotion for relieving pain, swelling or inflammation comprising:

the active ingredient consisting of oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles,

wherein the lotion is applied topically to the skin of an individual in need thereof.

26. An additive comprising:

the active ingredient consisting of oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles,

wherein the additive is added to another product.

CLAIM INTERPRETATION

The first step in an obviousness analysis is to determine the meaning and scope of each claim. *Amazon.com, Inc. v. Barnes and noble.com, Inc.*, 239 F.3d 1343, 1351, 57 USPQ2d 1747, 1752 (Fed. Cir. 2001). "Only when a claim is properly understood can a determination be made whether the claim . . . renders obvious the claimed invention." *Amazon*, 239 F.3d at 1351, 57 USPQ2d 1752 (Fed. Cir. 2001). For this reason, we begin with claim interpretation.

The claims comprise an "oatstraw extract." The oatstraw extract is described in all the pending independent claims as prepared by a process comprising four steps: 1) magnetically treating a quantity of water, 2) heating the magnetically treated water, 3) steeping oatstraw in the magnetically treated heated water, and 4) filtering the steeped oatstraw to remove oatstraw particles. Thus, the oatstraw extract is defined by the process by which it is made; it is a product-by-process claim.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself." *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). However, when the process steps confer structure or characteristics on the product which distinguishes it from products made by other processes, the process steps should be considered. *See*, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

In this case, the issue is whether the step of "magnetically treating a quantity of water" distinguishes the water used to prepare the oatstraw extract from untreated water. We agree with the Examiner that it does not (Answer 7). Although the claim recites that the extract is prepared "by magnetically treating a quantity of water," it does not require the magnetic treatment to impart a specific property or characteristic to the water.

Appellant provides evidence that magnetic treatment can change the properties of water (Br. 15-17). Kochmarsky (*Magnetic and Electrical Separation* 7: 77-107, 1996) and Johnson (*J. Clin. Periodontology* 25: 316-321, 1998) were introduced by Appellant during prosecution for "showing . . . the effects of magnetization on water" (Br. 16). We have considered these publications, but are not persuaded by Appellant's arguments. In each publication, a specific external field and/or device was used to magnetically treat the water to achieve the reported "structural" effect on the water. The claims at issue in this appeal are not limited to the particular magnetic field strength and/or device utilized in Kochmarsky or Johnson. They encompass magnetic treatment of any strength or duration; there is no evidence in the record to establish that any amount of magnetic treatment for any length of time would distinguish the water from untreated

water. Although there may be conditions under which magnetic treatment does change water structure, these conditions are not recited in the claims. The claims are broader.

Our mandate is to give claims their broadest reasonable interpretation. "Giving claims their broadest reasonable construction 'serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.' *Yamamoto*, 740 F.2d at 1571; accord *Hyatt*, 211 F.3d at 1372; *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989) ('An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.')." *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The recited process is not limited to specific magnetic treatment conditions; nor does it expressly require the magnetized water to possess a characteristic or structure that would distinguish it from untreated water. Consequently, we do interpret the process limitation of "magnetically treating a quantity of water" broadly to read untreated water.

After the water is magnetically treated and heated, the oatstraw is steeped in the water and then the "steeped oatstraw" is filtered "to remove oatstraw particles." In this case, we interpret the process limitations to require that the extract comprise water and also that it be separated from solid oatstraw particles.

FINDINGS OF ACT

Weed

1. Oatstraw comprises the green stalk, leaves, and grain of oat (Weed, p. 201).

2. Weed teaches that oatstraw is recommended "for itchy dermatitis, like chicken pox" (Weed, p. 197).

3. Weed describes an oatstraw bath:

> 1) "Add reheated, strained oatstraw infusion to a tub of hot water. Immerse self and soak away tensions" (Weed, p. 205).
> 2) "Boil water and pour over oatstraw in a large tub. When cooled sufficiently, bathe. (Yes, with the oats and all)"

(Weed, p. 205).

Jakobson

4. Jakobson describes various oils, including lavender oil, as a bath additive (Jakobson, col. 5, ll. 11-26). "These oils impart a medicinal activity to the bath additive composition . . . in that they exert a relieving or healing action on the human body and/or exhibit their therapeutic activity" (Jakobson, col. 5, ll. 21-25).

5. Example 6 shows a water-soluble oil foam bath composition comprising lavender oil (Jakobson, col. 8, ll. 25-34).

Puchalski

6. Puchalski teaches that a polyol can be added to a bath and shower gel "to enhance skin feel" Puchalski, col. 3, ll. 22). Glycerin[1] is listed as a suitable polyol among a list of six other polyols (Puchalski, col. 3, ll. 25-31).

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[1] "Glycerin" is the same product, but a different spelling of "glycerine."

Patrasenko

7. Patrasenko teaches treating water with a magnetic device and then filtering it.

8. The water is treated "under action of a magnetic field of induction 20-80 mT" (Patrasenko, Abstract).

9. The treated water "corresponds to quality standards of drinking water and has curative-prophylactic properties" (Patrasenko, Abstract).

Ito

10. Ito teaches an apparatus for treating water with a magnetic field (Ito, col. 1, ll. 48-66).

Level of ordinary skill in the art

11. Puchalski teaches that various optional ingredients can be included in its bath and shower gels, including viscosity enhancers "to promote good feel and/or adjust viscosity" (Puchalski, col. 2, ll. 56-63), preservatives (Puchalski, col. 3, ll. 7-15), polyols "to enhance skin feel," such as the claimed glycerin (Puchalski, col. 3, ll. 22-31), and fragrances (Puchalski, col. 3, l. 60).

12. Jakobson also teaches optional ingredients may be added to its bath composition, including oils for their "pharmacological or medicinal therapeutic properties," such as the claimed lavender oil (Jakobson, col. 5, ll. 11-26), perfumes (Jakobson, col. 5, 45-53), "solutions of vegetable extracts . . . as further therapeutically active substances" (Jakobson, col. 5, ll. 54-58), and other additives and adjuvants (Jakobson, col. 6, ll. 45-51).

13. Thus, based on the teachings of Puchalski and Jakobson, we find that it was conventional for one of ordinary skill in the art at the time the invention

was made to choose and combine known skin care components as additives to skin care products for their known and expected properties.

DISCUSSION

Claims 1, 5-9, 17-20, 22, 24-26, and 30 stand rejected under 35 U.S.C. § 103(a) as obvious over Weed in view of Puchalski and Jakobson, and further in view of Ito or Patrasenko (Answer 3). The Examiner contends that Weed teaches a hot water extract of oatstraw in the form of a bath for treating various conditions, including skin disease (Answer 3). The Examiner acknowledges that Weed does not teach glycerin and lavender oil in its oatstraw extract, but the latter were known topical ingredients (Answer 4). The Examiner concludes:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a water extract (infusion, or tincture) and combine[] with glycerin in order to benefit from the enhanced skin feel imparted by glycerin as taught by Puchalski and by the addition of lavender oil in order to benefit from the relieving or healing action of lavender oil as taught by Jacobson.

(Answer 4.)

The Examiner also contends that, as evidenced by Patrasenko and Ito, "magnetic treatment of water is well-known in the art and [it] would have been obvious to one of ordinary skill in the art to use such process for [ ] cleaner water" for preparing a therapeutic composition (Answer 9).

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). In our opinion, the Examiner has presented sufficient evidence to establish prima facie obviousness of the claimed subject matter.

Contrary to Appellant's arguments, Weed expressly teaches an oatstraw extract. Weed states: "Add reheated, strained oatstraw infusion to a tub of hot water. Immerse self and soak away tensions" (Weed, p. 205; Findings of Fact 3). The phrase "strained oatstraw" indicates that the liquid has been separated[2] from the solid oatstraw particles, satisfying the claimed limitation of "oatstraw extract" as we have interpreted it. Appellant's argument that the "following Weed would find the experience time-consuming, frustrating and in fact irritating to the skin due to the added effort necessary to remove the oatstraw clumps and residue" (Affidavit of inventor Lorraine Mignault at ¶ 6) ignores Weed's teaching of a strained oatstraw infusion.

Appellant's statement that the rejection under 35 U.S.C. § 103 should be reversed because "[n]o references have been cited which teach or suggest filtering of an aqueous oatstraw suspension" (Br. 5) is flawed since Weed teaches an oatstraw infusion which is strained; the term "strained" means "filtered."[3]

In our opinion, the evidence of record shows that the subject matter of claim 1 is a combination of known components selected for their known properties in benefiting the skin. A claim which unites elements with no change in their respective functions to yield a predictable result is not patentable in the absence of secondary considerations.

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[2] "Strainer . . . 1. A filter, sieve, colander, or the like having meshes or porous parts and used to separate liquids from solids." *The American Heritage Dictionary of the English Language* 1272 (New College Edition 1976)

[3] *Id.*

> For over a half century, the [Supreme] Court has held that a "patent for a combination which only unites old elements with no change in their respective functions ...obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 [87 USPQ 303] (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

KSR Int'l v. Teleflex Inc., 82 USPQ2d 1385, 1395 (2007).

No explicit teaching is necessary to have led the skilled worker to the particular components – oatstraw, lavender, and glycerine – recited in claim 1 because each was known in the prior art to be effective and beneficial in skin care compositions, prompting the skilled worker to have combined them.

The legal conclusion of unpatentability for obviousness depends on four factual inquiries identified by *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). These inquiries concern: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness. Against this background, the obviousness or nonobviousness of the subject matter is determined. *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1388 (2007).

As explained in more detail below, based on the teachings of Puchalski and Jakobson, we find that it was conventional for one of ordinary skill in the art at the time the invention was made to choose and combine

known skin care components as additives to skin care products for their known and expected properties (Findings of Fact 13).

For example, Puchalski teaches that various optional ingredients can be included in its bath and shower gels, including viscosity enhancers "to promote good feel and/or adjust viscosity" (Puchalski, col. 2, ll. 56-63), preservatives (Puchalski, col. 3, ll. 7-15), polyols "to enhance skin feel," such as the claimed glycerin (Puchalski, col. 3, ll. 22-31), and fragrances (Puchalski, col. 3, l. 60) (Findings of Fact 11).

In addition, Jakobson teaches optional ingredients may be added to its bath composition, including oils for their "pharmacological or medicinal therapeutic properties," such as the claimed lavender oil (Jakobson, col. 5, ll. 11-26), perfumes (Jakobson, col. 5, 45-53), "solutions of vegetable extracts . . . as further therapeutically active substances" (Jakobson, col. 5, ll. 54-58), and other additives and adjuvants (Jakobson, col. 6, ll. 45-51) (Findings of Fact 12).

Thus, choosing oatstraw, lavender, and glycerin for their known benefits in a skin care product would have been a customary and normal activity at the time the invention was made for persons of ordinary skill in the art.

Appellant contends that "Weed does not teach or suggest that other compounds may be added or that the oatstraw suspension may be mixed with other compounds" (Br. 8). Appellant asserts that "Puchalski teaches a long list of optional components which may be added to the shampoo and bath gel products, none of which is oatstraw. Jakobson teaches a polyglycerol fatty acid ester mixture to be added to a bath which does not list oatstraw as a potential additive" (Br. 8). We do not find these arguments

persuasive. As discussed above, both Puchalski and Jakobson teach that it was conventional to formulate multi-component skin care products, selecting additives based on their known and expected advantages in a skin care product.

Appellant also argues that the products cited by the Examiner are "incompatible" (Br. 8). "Puchalski teaches a body wash product whereas Weed and Jakobson effectively teach bath additives, one of which is water soluble (Weed) and one of which is not (Jakobson) and that as discussed above there would therefore be no incentive to combine these references" (Br. 8). We are not convinced by this argument. All three of the cited references are directed to skin care products containing components which are described as beneficial to the skin. (Appellant's Specification states that the claimed lotion can be used to produce "body washes" (Specification 9), the same technology described in Puchalski.) Accordingly, a person of ordinary skill in the art would reasonably been expected to look to them because they are pertinent to the same problem – skin care – addressed by Appellant's claimed invention. *See In re Kahn*, 441 F.3d 977, 986-987, 78 USPQ2d 1329, 1335-1336 (Fed. Cir. 2006).

Because we have interpreted the scope of the claim to be met by untreated water, it is not necessary for us to address the obviousness of combining Ito or Patrasenko – which teach magnetized water – with Weed in view of Puchalski and Jakobson. Nonetheless, we have considered the declarations provided by Mr. Green (the "Green Declaration" – letter dated Oct. 1, 2002 written by Richard Green, M.Sc.) and inventor Lorraine Mignault which conclude that oatstraw extract prepared with magnetized

water differs from extract prepared with untreated water. However, we do not find the evidence persuasive.

Mr. Green is a senior scientist for POS Pilot Plant Corporation (POS) which was employed by the inventor to develop her skin care lotion (Green Declaration 1). Mr. Green states that "[o]ne sample of skin care lotion was prepared using the client's magnetized water and the second sample was prepared using the POS de-ionized water supply" (Green Declaration 2). The demagnetized water had a pH of 7.5, a conductivity of 152 micro-ohms, and was produced using a Teledon magnetic filter (Green Declaration 1). The de-ionized water had a pH of 5.79 and a conductivity of 2.2 micro-ohms (Green Declaration 1). Green concludes: "I felt the skin care lotion prepared using the water supplied by the client (identified as magnetized water) was more effectively applied and absorbed through the skin in comparison to the same formula prepared using de-ionized water supplied at POS" (Green Declaration 2).

To the extent that the magnetized water confers a particular pH and conductivity on the water, we agree with Appellant that these characteristics could be sufficient to distinguish the magnetized water from untreated water. However, there is insufficient objective evidence in the Green Declaration to establish that these differences were imparted by magnetic treatment. Mr. Green utilized water obtained from his laboratory and magnetized water supplied by the inventor to prepare the lotions (Green Declaration 1). Mr. Green did not report the pH or conductivity of the inventor's water prior to magnetic treatment. Consequently, it can not be determined whether the pH and conductivity values reported for the magnetized water were produced by

the magnetic treatment or whether they were characteristic of the inventor's water prior to treatment.

In addition, the claims are not limited to magnetized water having the properties which were tested by Mr. Green. In particular, the magnetized water, after treatment with a Teledon magnetic filter, had a pH of 7.5 and a conductivity of 152 micro-ohms (Green Declaration 1). There is no evidence that magnetized water produced by any magnetic field would have these properties. There is also no evidence that the results observed by Mr. Green after application of the lotion are characteristic of a lotion produced from any magnetic water, or only the magnetic water having the particular pH and conductivity used in his test. Thus, the test results are not commensurate with the scope of the claims.

The declaration is also deficient because Mr. Green does not describe the specific content of the oatstraw lotion which was tested (e.g., did it have glycerin? lavender?). Absent such information, it can not be determined whether the lotion falls within the scope of the claims, and if it does, whether the evidence is commensurate with the scope of the claim.

Finally, Mr. Green did not present objective and probative evidence of the improvement in the lotion's properties. He states that "I felt the skin care lotion prepared using the water supplied by the claimed (identified as magnetized water) was more effectively applied and absorbed through the skin," but does not explain how this conclusion was reached nor what he means by "effectively applied" and "effectively. . . absorbed."

For the foregoing reasons, we affirm the rejection of claim 1. Appellant argues that claims 8, 17, 18, 20, and 25 are separately patentable, but the arguments they present (Br. 20-21) are the same we have already

considered for claim 1. Consequently, we also affirm the rejection of these claims. Claims 5-7, 9, 19, 22, and 24 fall with claim 1 because they were not separately argued.

Claim 26

Claim 26 is directed to an additive comprising "oatstraw extract" prepared by the same process recited in claim 1. As discussed above, Weed teaches a filtered oatstraw extract which meets the claimed limitation of an "oatstraw extract." The recitation of "wherein the additive is added to another product" is an intended use of the oatstraw extract additive. It does not further limit the scope of the claim. Accordingly, we find that claim 26 is anticipated by Weed. Since "anticipation is the epitome of obviousness," we do not designate this as a new ground of rejection. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Claim 30 falls with claim 26 because it was not separately argued.

SUMMARY

We affirm the rejection of claims 1, 5-9, 17-20, 22, 24-26, and 30.

OTHER ISSUES

If prosecution of this application is resumed, the Examiner should consider the relevance of the following references to the patentability of the claimed subject matter:

1) Ody (*The Complete Medicinal Herbal* 40 (1993) describes a fluid extract of oats.

2) Jensen (U.S. Pat. No. 5,064,675) describes an additive comprising oat extract ("Avena sativa") and lavender ("Lavendula officinalis") (Jensen,

col. 5, ll. 26-33). Jensen also describes how to prepare a filtered oat extract from herbal materials (Jensen, col. 4, ll. 28-35).

3) Kirkpatrick (U.S. Pat. No. 5,932,251) teaches magnetized water for preparing topical lotions (Kirkpatrick, col. 3, ll. 37-38).

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED.

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